

making the **combination inoperative**. The Second Office Action fails to even address this point.

As another example, on pages 7-8 of the Amendment, assignee points out an error in the Office's understanding of the claim language "non-invasive". Not only does the Second Office Action fail to acknowledge the correction, it again relies on the **erroneous claim construction** in rejecting claims 1-26.

As further examples, on page 7 of the Amendment, assignee respectfully asks the Office to identify all instances of official notice, after giving two examples of assertions that might be viewed (when giving the First Office Action the benefit of the doubt) as statements made in reliance on official notice. But the Second Office Action ignores the invitation to clarify the support for the two examples, and also ignores the request for clear identification of all instances of **official notice**. Assignee therefore understands that the Office has chosen not to rely on official notice at all, in any rejection.

As another example, on page 7 of the Amendment, assignee points out that the dependent claims were rejected *en masse* instead of being individually analyzed as they should be. The Second Office Action ignores this basic legal requirement, and once again the Office fails to support the rejections with an analysis that matches each claim limitation to a specific prior art citation or other *prima facie* basis for rejection. This is not a mere formality. The Office Actions' cursory *en masse* approach **fails to even recognize claim limitations** such as the switchover limitation of claim 109, the dual host limitation of claim 88, the circular buffer limitation of claim 87, the data fork limitation of claim 86, the integrity check limitation of claim 62, the storage capacity limitation of claim 34, the hot-swap limitation of claim 32, and numerous other claim limitations.

These are fundamental gaps in the Office Actions. Even if the rest of the Second Office Action was correct (it is not), the Office's failure to address the points above is reason enough to do at least the following:

- withdraw or reverse the rejection of claims 1-26 because it relies on the improper Ohran – Double-Take combination;

- withdraw or reverse the rejection of claims 1-26 because it uses an erroneous interpretation of "non-invasive"; and
- withdraw or reverse the rejections of at least the dependent claims because the rejections rely on an improper *en masse* dismissal that fails to consider each limitation of each claim.

No evidence was given to support the claim 27 inherency rejection

As noted by assignee on page 6 of the Amendment, the First Office Action failed to address the spoof packet generator limitation of claim 27. Rather than citing specific prior art, the Second Office Action reacts by asserting on pages 2-3: "Since the combination of the references in the rejection is a mirror storage system over a TCP/IP network, it is inherent that it has a packet generator related to the mirroring process (including any spoof packet required)...."

But the Office provides **no evidence** that a mirror storage system over a TCP/IP network requires a spoof packet generator as claimed. An inherency rejection is not proper unless the characteristic in question **must** occur. Mere possibilities are not enough:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). M.P.E.P. § 2112 (emphasis in original).

Because the Office failed to provide any evidence supporting inherency of spoof packet generators in data mirroring systems, the rejection of claim 27 is not proper.

Claims 76-88 are not indefinite

As noted by assignee on page 7 of the Amendment, the First Office Action failed entirely to address claims 76-88. Even though it rejected them, it provided **no discussion** of those claims or of their relationship to the prior art. Instead of providing such an analysis, the Second Office Action now asserts that the meaning of these claims is unclear because the term "flexible mirroring characteristic" renders the claims indefinite.

However, the term "flexible mirroring characteristic" is clear and definite when properly read in context. First, there is no question that assignee is entitled to use such terminology:

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought. M.P.E.P. § 2173.01 (emphasis in original).

"During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)." M.P.E.P. § 2111.01.

Persons of skill in the art would **look at the other claims** to determine what is a "flexible mirroring characteristic". In doing so, they would find a list of flexible mirroring characteristics in claim 1, and consistent with that list they would find references to specific flexible mirroring characteristics in at least claims 7, 8, 9, 10, 15, 16, 17, 18, 19, 21, 22, and 27. Persons of skill in the art would also find a **discussion of "flexible mirroring characteristics"** in the **Summary** section on pages 53-54 of the application.

In short, under either a “plain meaning” analysis or a “clear definition in the specification” analysis, the meaning of “flexible mirroring characteristic” is clear. The Section 112 rejection of claims 76-88 is not proper and should be withdrawn.

The references were not properly combined

The Amendment explained at length on pages 3-6 why the reference combinations relied on by the First Office Action were not proper. Aside from repeating the First Office Action, the Second Office Action addresses this issue in a single paragraph on page 2. This paragraph asserts two grounds for combining references.

The first ground asserted is that “the FrameRunner reference is a storage product advertisement that listed the desirable characteristics of the product. Hence, the desire or motivation to have any of the characteristics listed is implicit by the nature of the reference.” But this ground is not sufficiently specific and factual to meet the requirements set forth in cases such as In re Dembiczak. Indeed, the Second Office Action fails to identify any specific teaching of the FrameRunner reference that could have served as a suggestion or motivation to combine – it relies instead on something that the Office admits is at best merely implicit. Moreover, the reasoning in the Second Office Action is fallacious because it is too broad – if accepted, it would justify combining any reference with any other reference(s) whenever the first reference indicates that any characteristic of a technology is desirable. That is not consistent with the case law.

The second ground asserted is that in “the Ohran reference, the motivation is explicitly provided by the reference – col.11 lines 10-14 – to make the remote storage appears as a local device (i.e. to provide transparency).” But this ground again fails to identify another specific reference. Nor does it explain why a discussion in Ohran of making remote storage appear like a local device would have led one of skill to combine Ohran with references that teach other things. Finally, as noted above, the Second Office Action also failed to address the inoperativeness that would apparently arise from combining Ohran with Double-Take.

For these reasons, and those provided in the Amendment, assignee maintains that the references were not properly combined.

Amended claim 101 should not be rejected by equating it with claim 27

Proper rejection of a claim must address each limitation of the claim – claim limitations may not be ignored. But pages 6-7 of the Second Office Action reject claim 101 “under similar rationale as for claim 27” without addressing differences between the two claims. As noted, claim 27 has a spoof packet generator limitation, which claim 101 does not. Claim 27 also requires at least two primary network servers, and a many-to-one multiplicity flexible mirroring characteristic, neither of which is required by claim 101. Conversely, claim 101 requires transmission using at least one of Ethernet packets and TCP packets, and transmitting to a serverless remote mirroring unit, neither of which is required by claim 27. Rejection of claim 101 can be properly based only on an analysis of the limitations of claim 101 – all of that claim’s limitations, and no others – and on the relation of those limitations to the prior art. Because the Office has not met the burden of providing such an analysis, the rejection should be withdrawn.

Summary

The rejections should all be withdrawn. The Office has failed to address major errors in the rejections, by ignoring claim limitations and misinterpreting claim language, for example. The claims are not indefinite, and they are not inherent in the cited art. The references have also been combined improperly, without the required specific suggestion or motivation, and in a way that is apparently inoperative.

Assignee respectfully maintains that the pending claims are allowable. Assignee’s silence here does not signify agreement or acquiescence in the Office Action’s assertions. Assignee reserves all arguments, and maintains the arguments provided in the Amendment.

If any questions remain, the undersigned welcomes a telephone conference or other communication from the Office.

Dated March 3, 2003.

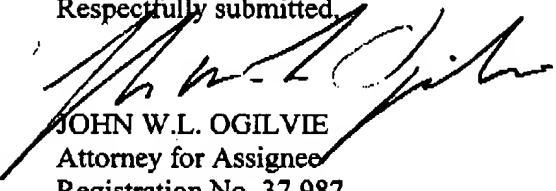
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I hereby certify that this Response is
being faxed to the USPTO on March 3,
2003, to the number 703-746-7239:

Respectfully submitted,


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